

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Philip S. Langridge)
Application No:) Art Unit: 3691
10/759,957) Confirmation No.: 8173
Filed: January 16, 2004) Examiner: Michael R. Zecher
For: CUSTOMIZABLE TRADING)
DISPLAY OF MARKET DATA)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") requests review of the Final Office Action mailed May 1, 2008 in the above-identified application. The Request is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 50-3938.

REMARKS

I. Status of the Application

Claims 13-37 are pending in the application, of which claims 13, 24 and 31 are independent claims.

In a Final Office Action dated May 1, 2008 (the “Final Office Action”), the Examiner rejected all of claims 13-37 under 35 U.S.C. §103(a) as being unpatentable over U.S. 6,195,647 (“Martyn”) in view of U.S. Patent Publication 2002/0161690 (“McCarthy”). However, Applicant respectfully contends that the rejection of these claims on the grounds presented by the Examiner contain clear legal and factual deficiencies. For at least the following reasons, Applicant requests review of the Final Office Action.

II. The Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 13-37 under 35 U.S.C. §103(a).

1. There is No Substantial Evidence of Motivation to Modify

On page 3, the Final Office Action concedes that Martyn does not disclose various recitations of claim 13, which are incorporated by reference in claims 13-37. After asserting that McCarthy discloses these features, the Final Office Action argues – in a single, conclusory sentence – that one of ordinary skill in the art would be motivated to modify Martyn to incorporate these features for the following reason:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martyn et al. to include non-benchmark securities related to a selected benchmark security, whereby the benchmark security and non-benchmark securities make up different instruments, and displaying the market data in grids as taught by McCarthy et al. *in order to allow a trader to use various trading interfaces to create orders, manipulate orders, cancel orders, cycle through multiple issues,*

obtain trading information more relevant than limit price stacks, or efficiently buy or sell items inside or within a spread market.

Final Office Action, pp. 3-4 (emphasis added). Accordingly, the Examiner asserts that one of ordinary skill in the art would be motivated to modify Martyn for the sole reason that such combination would achieve various benefits, including the ability to create and cancel orders.

The Examiner's proffered motivation is a finding of fact, and all findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). The Supreme Court has described "substantial evidence" in the following manner: "substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence." *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); *see also Dickinson v. Zurko*, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) ("*Zurko III*").

However, the Examiner's proffered motivation lacks substantial evidence within the record. The Examiner has not cited any references or any other authority for the list of benefits cited, or for the proposition that these benefits would motivate one of ordinary skill in the art to selectively modify Martyn to incorporate specific features of McCarthy in order to achieve the claimed invention. In fact, the Examiner's single, conclusory assertion concerning a motivation to modify Martyn provides no evidence or support whatsoever. The Examiner has therefore failed to establish a *prima facie* case of obviousness for claim 13. Applicant demands that the Examiner produce evidence for the proffered motivation if the rejections are to be maintained. Even if a rejection is maintained or raised, Applicant submits that final rejection here is premature.

2. There is No Rational and Articulated Reason to Combine

Furthermore, the rejection of Claim 13 is improper because the Examiner's unsupported assertion fails to provide a rational and articulated reason for combining the teachings of Martyn and McCarthy. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int'l Co. v. Teleflex Inc.*, -- U.S. --, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must explicitly articulate the reasoning for combining teachings from different references. The Federal Circuit stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *To facilitate review, this analysis should be made explicit.*

KSR Int'l Co., 127 S.Ct. at 1740-41 (emphasis added). Vague and conclusory statements are insufficient to establish a reason for combining the teachings of different references. *See Innogenetics*, 512 F.3d at 1373-74 (excluding obviousness testimony that was “vague and conclusory” regarding the motivation to combine references). Here, the Examiner’s single, conclusory assertion that various benefits would motivate one of ordinary skill in the art to selectively modify Martyn to incorporate specific features of McCarthy is “vague and conclusory,” at best. Therefore, the proposed combination of Martyn and McCarthy is improper.

For at least these reasons, the rejection of Claim 13 should be withdrawn.

Claims 14-37 incorporate the features of claim 13 by reference. Applicant submits that these claims are patentable for the reasons discussed above with respect to claim 13, and further due to the additional features that they recite.

CONCLUSION

Because the Examiner failed to establish a *prima facie* case of obviousness with respect to claims 13-37, withdrawal of the rejections is respectfully requested.

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(Monday, Sep. 1 = Labor Day)

Respectfully submitted,

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